

U.S. Patent Appln. No. 10/626,108
Response Dated Dec. 12, 2005
Reply to Office Action of Aug. 11, 2005
Docket No. BOC9-2003-0006 (375)

REMARKS/ARGUMENTS

These remarks are submitted in response to the office action dated August 11, 2005 (Office Action). This response is filed after the 3-month shortened statutory period, and as such, a retroactive extension of time is hereby requested. The Examiner is authorized to charge the appropriate extension fee to Deposit Account 50-0951.

Claims 7, 9, 1, 14, 15 and 17 were rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2004/0267531 to Whynot, *et al.* (hereinafter Whynot). Claims 1-3, 11, 13 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2004/0151284 to Adamczyk (hereinafter Adamczyk) in view of U.S. Patent No. 6,697,474 to Hanson, *et al.* (hereinafter Hanson). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adamczyk in view of Hanson and further in view of U.S. Published Patent Application No. 2003/0135569 to Khakoo, *et al.* (hereinafter Khakoo). Claims 5, 6 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adamczyk in view of Hanson and further in view of U.S. Published Patent Application No. 2004/0186889 to Washburn, *et al.* (hereinafter Washburn). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Whynot in view of Washburn.

In response to the claim objections raised at page 2 of the Office Action, Applicants have amended Claims 3 and 8-10. Applicants, accordingly, respectfully request that the objections be withdrawn.

Applicants' Invention Predates The Cited References

Independent Claims 1, 11 and 16, as noted above, were rejected as being unpatentable over Adamczyk in view of Hanson. As also noted above, independent Claims 7, 14, and 17 were rejected as being anticipated by Whynot. Applicants

respectfully disagree that the references, alone or in combination, teach or suggest Applicants' invention.

Applicants respectfully assert, however, that the issue is moot since Applicants conceived of their invention and actively pursued its reduction to practice from a time prior to the January 31, 2003, March 21, 2003, and June 30, 2003 effective dates of Adamczyk, Washburn, and Whynot, respectively. Applicants thus respectfully maintain that Whynot, Adamczyk, and Washburn can not be applied against Applicants' invention.

In support of their assertion, Applicants submit the Declarations attached hereto. The Declarations, along with evidence of activity on specific dates also submitted herewith, establish conception and continuing diligence from a time prior to the effective dates of each of Whynot, Adamczyk, and Washburn.

The Declarations are accompanied by a copy of Confidential Invention Disclosure No. BOC8-2002-0102, titled "A Method to Enable Instant Collaboration Via the Use of Pervasive Messaging" (Disclosure). The Disclosure was submitted by Applicants on September 27, 2002, to an IP professional employed by the assignee of the invention, International Business Machines Corporation (IBM). The disclosure was revised by Applicants on September 30, 2002. The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as September 30, 2002, which predates the effective dates of each of Whynot, Adamczyk, and Washburn.

The Disclosure is an IBM confidential disclosure form. It is a standardized document utilized, according to established IBM procedures, by IBM inventors upon their conception of an invention. The procedures established by IBM govern the internal use of the confidential disclosure forms. One aspect of IBM's procedures governing the use of the confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after its submission to an IBM Attorney/Patent Professional. Any

such changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added.

The present application, including each claim, was prepared based upon Applicants' Disclosure attached hereto. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the application prior to its submission to the U.S. Patent and Trademark Office to ensure that the claims and material contained therein were fully supported by the Disclosure.

The Disclosure provided the basis of each of the claims in the application. The text and figures of the Disclosure explicitly describe each aspect of Applicants' invention recited in the claims. (See Disclosure, pp. 2-3.) The Disclosure describes, for example, the recited features of a method to enable instant collaboration via the use of pervasive messaging. The Disclosure additionally describes, for example, aspects of a system for enabling instant collaboration.

Applicants exercised due diligence from prior to the effective dates of Whynot, Adamczyk and Washburn through to the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declarations, once an IBM disclosure form is completed, the disclosure is reviewed by an internal Invention Review Board (the Board) within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon the Board's reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions for preparing the application together with the IBM invention disclosure form are then conveyed to the outside counsel. Outside counsel prepares a draft of the application. The application is subsequently reviewed by each inventor. The inventors, according to this standard procedure, must be satisfied that the application sufficiently details the inventive concepts described in the Disclosure.

Consistent with these established procedures, during the period between September 30, 2002, and July 24, 2003, an outside search firm conducted an initial patent search, the Board assigned the application to outside counsel, and outside counsel drafted the present application. The draft application prepared by outside counsel was reviewed by the inventors, with whose input the application was finalized in its submitted form. This activity of reviewing a patent application is consistent with the exemplary activities often noted as satisfying the legal requirements for a showing of diligence. *See, e.g.*, MPEP 715.07(a). Evidence of these activities is presented in Composite Exhibit "A," attached hereto:

1. Confidential invention search results sent to IBM on December 10, 2002, and marked as received on December 10, 2002;
2. Correspondence from IBM to outside counsel on January 5, 2003, instructing outside counsel to prepare and file Application;
3. Correspondence from outside counsel to IBM on February 11, 2003, confirming assignment;
4. E-mail correspondence from Inventor Mansey to outside counsel on July 3, 2003, responding to the inquiry from outside counsel regarding the review of the draft of the Application;
5. E-mail correspondence from outside counsel to inventors on July 9, 2003, forwarding the final draft Application;
6. Facsimile correspondence from the IBM IP Law Department to outside counsel on July 17, 2003, forwarding the signed formal papers for filing the Application.

Consistent with professionally-accepted practices, outside counsel prepares cases on a "first come, first served" basis, though applications associated with bar dates are granted priority within the work queue. As proof that the present application was included within the work queue and receiving due attention, Applicants submit herewith outside

U.S. Patent Appln. No. 10/626,108
Response Dated Dec. 12, 2005
Reply to Office Action of Aug. 11, 2005
Docket No. BOC9-2003-0006 (375)

counsel's electronic docket sheet, titled "Actions Due," which shows a "Date Created" of February 13, 2003. This evidence is attached hereto as Exhibit "B."

Applicants respectfully submit that the evidence convincingly establishes reasonable diligence from a time prior to the effective dates of Whynot, Adamczyk and Washburn to the filing date of the present Application. Accordingly, Applicants respectfully maintain that when coupled with the evidence of conception, the evidence of Applicants' diligence effectively removes Whynot, Adamczyk and Washburn from consideration against Applicants invention. Applicants respectfully maintain further that each of the claims, therefore, defines over the prior art.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: December 12, 2005



Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Marc A. Boillot, Registration No. 56,164
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000